

REMARKS

Claims 1, 4-5, 6-11, 13, and 21-24 are active.

Claims 1 and 5 are amended to remove reference to pigmentation mark/defect.

Support for amended claim 1 is found on page 7 as originally filed.

Claims 21-22 find support on page 4, line 37 to page 5, line 3.

Claims 23-24 find support on page 7, lines 31-36.

No new matter is added.

The claims of this application are to a scrubbing process of treating a skin irregularity that may include, wrinkles, fine lines, scars and others by applying high concentrations, e.g., at least 10% by weight of 8-hexadecene-1,16-dicarboxylic acid to the skin, leaving on the skin for 5 minutes to 30 minutes and then rinsing it off (see also page 2 of the application).

In the Official Action, the Examiner has maintained the obviousness rejections citing Harding, research disclosure #477 and the internet article describing Aralalone, and DE 101 50 734 and its U.S. counterpart (US 2005/0008665) all in view of Reynolds. Jones is again cited to suggest that including salicylic acid in a chemical scrub would also have been obvious.

The Examiner finds that defining the process as a chemical scrubbing process is not suitably distinguishing as the active steps in the method (topically application) is also described in the citations. In addition, the Examiner finds that the time the composition is left in contact with the skin, the amounts of the dicarboxylic acid and then rinsing off a cosmetic are obvious. In addition, regardless of different mechanism of action (biological vs. chemical), the methods of how the compositions are applied in the cited art are alleged to be the same.

Harding relates to the reduction of melanine production. See col. 12. Therefore, as explained previously Harding's teachings are that the dioic acids are to be applied to effectuate a biological mechanism and not a chemical mechanism as is a chemical scrubbing process as claimed. Signs related to melanin production increase are those cited in the Abstract (e.g., melanine is induced when skin is exposed to sun UV). However it would not have been obvious starting from Harding to expect a decrease in skin irregularities by a chemical mechanism by way of a chemical scrub, which are well-known to the skilled person (see also the paragraph bridging pages 1-2 of the present application).

The research disclosure teaches a composition comprising from 0.0001 to 10% of dioic acid that is useful for day and night creams (as described in this document) and contrary to the Examiner's contention are intended to be kept on the skin and not to be rinsed off. In contrast, the scrubbing process presently claimed require high amounts of dioic acid (at least 10% or more). That is why rinsing off the composition is needed after application. This cited document encourage to use low amounts of dioic acid and accordingly the one skill in the art would not have been motivated to rinse off the composition as described in Reynolds, the Research Disclosure #477 at least within the time period prescribed by the present claims.

Applicants respectfully disagree as none of the cited documents, even in combination, teach or suggest to use of dioic acid in a scrubbing process in the amounts claimed nor is there motivation to do so in the 3 steps as recited in Claim 1. Indeed, the Examiner's conclusions of obviousness "it would have been obvious to one of ordinary skill in the art to keep the formulation on the skin to achieve a desired purpose" is an unsupported position and finds no basis in the material cited in the rejections. ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007)). See also *In re Lee*, 277 F.3d 1338,

1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (“ ‘The factual inquiry whether to combine references must be thorough and searching.’ ...It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with.”). Further exasperating this issue is the Examiner’s assertion on page 3 lines 5-6 of the Official Action that sunscreens are rinsed off routinely. Not only is this statement unsupported, it is factually incorrect, sunscreens are not intended to be rinsed, that is the reason why it is recommended to apply them again after one goes into contact with water (like swimming) and even if the sunscreen is at some point washed off (e.g., like after the outdoor activity), this is certainly no basis to allege that leaving the composition in contact for 5 to 30 minutes and then rinsing as recited in Claim 1. Otherwise, there would be no purpose of applying sunscreen as washing it off would render the purpose of sunscreen useless when that individual is exposed to the harmful ultraviolet rays of the sun. This same principle applies to Harding’s composition to be left on the skin for a period of time that far exceeds the maximum 30 minutes and the day night cream of the Research Disclosure #477. *Kahn* 441 F.3d 977, 985-86 (Fed. Cir. 2006): “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.”

That is, these compositions are intended to be left on the skin for a period of time that far exceeds the 30 minutes maximum recited in Claim 1 of the present application. The Examiner’s simple and unsupported conclusion that either it is well-known to rinse off a composition or relies on Reynolds for this step in the claim. However, a composition that is to be applied and effect a biological mechanism may need the composition to be kept on the skin and it would not be intended to be rinsed off. Further regarding the day/night cream in the research disclosure is well-known by the skilled person to be applied and kept on the skin

and it would not be intended to be rinsed off. Even if the Examiner still maintains the unsupported allegation that Harding's and/or the Research Disclosure #477 composition is to be rinsed off, there are no teachings in Harding or Research Disclosure #477, with Reynolds and/or Jones to apply the composition for a specific range of time (from 5 minutes to 30 minutes) as recited in the claims before rinsing the composition off the skin. Indeed, Reynolds teachings have no basis to suggest leaving on a composition that specifically contains 8-hexadecene-1,16-dicarboxylic acid for the time specified in the claim and rinsing it off. Rather, Reynolds teachings are germane to a composition including almond meal, oatmeal, cosmetic clay, witch hazel and benzoin (see col. 2).

The DE '734 publication is cited and acknowledged on page 1 of the present application (see lines 31-34) and teaches 8-hexadecene-1,16-dicarboxylic utility for pigment problems and suggests the use as a skin lightener (see also page 1 of the US counterpart) comprising 0.001 to 10% (preferably 0.005 to 5%) of dioic acid (see [0037], [0046], [0064], and claim 9). Reynolds and Jones are cited for the same purposes as in the first two sets of rejections. As amended, Claim 1 does not seek to apply the chemical scrub to effect pigmentary marks and as such this rejection is no longer applicable.

Regarding Claims 21-22, the compounds defined in these claims improve the solubility of the 8-hexadecene-1,16-dicarboxylic acid, and when used at the high level defined in the claims provides advantageous effects of this dioic acid and its availability to effectuate the chemical scrubbing process. See also, page 4, line 37 to page 5, line 3.

Regarding Claim 24, the application with the cottonwool, a cotton bud, a brush, a gauze, a spatula or a pad, or a spray defines an advantageous embodiment of the invention as it is preferable to avoid contact with hands when dioic acid is used at the high level as claimed (>10%) as the contact with dioic acid may induce a chemical peeling of the body

U.S. application serial no. 10/589,975  
Reply to the Official Action of March 15, 2011

parts (e.g., hands and fingers) that may not need treatment or for which it is not desired to treat.

In view of the above discussion, withdrawal of the rejections is requested.

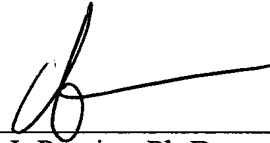
Allowance of the claims is requested.

Respectfully submitted,

Customer Number  
**22850**

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

Tel: (703) 413-3000  
Fax: (703) 413 -2220  
(OSMMN 08/03)

A handwritten signature in black ink, appearing to read 'Daniel J. Pereira', is written over a horizontal line.

Daniel J. Pereira, Ph.D.  
Registration No. 45,518